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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,050	03/02/2004	Janzen Lo	3186.00003	2830

7590

01/11/2006

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EXAMINER

KIM, JOHN

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Tok

Office Action Summary	Application No. 10/791,050	Applicant(s) LO ET AL.	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-9,12,14-21 and 23-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,10,11,13 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election **with traverse** of claims 1-36 in the reply filed on December 14, 2005 is acknowledged. The traversal is on the ground(s) that the application "would not present an undue burden on the Patent Office." This is not found persuasive because "a serious burden on the examiner may be shown by prima facie if the examiner shows separate classification." (MPEP section 808.02). In the instant case, the inventions have separate classifications, as shown in the previous restriction requirement.

The requirement is still deemed proper and is therefore made **FINAL**.

Applicant's election **without traverse** of species as disclosed in Figure 2 (implant with concentric cuts) in the reply filed on December 14, 2005 is acknowledged. Examiner notes that applicant failed to acknowledge which claims were generic to the elected species, thus examiner notes claim 13 is the only generic claim that reads upon the elected species. Furthermore, examiner did state claim 1 was generic in the restriction requirement and will continue to examine claim 1. After careful examination of the claims with respect to the elected specie, examiner notes only claims 1, 3, 10, 11, 13, and 22 reflect upon the elected specie. Thus, claims 2, 4-9, 12, 14-21, and 23-36 are withdrawn from further consideration based on the nonelected species. The above-mentioned withdrawn claims focus on embodiments of implants with pin holes, counter bore cuts, tiered concentric cuts, rectangular concentric cuts, radial cuts, a hollow core,

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and being tapered. Since these embodiments were not elected, withdrawal of these claims are deemed proper.

Claims 37-38, 39, and 40-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 14, 2005.

Drawings

The informal drawings (submitted March 2, 2004) are not of sufficient quality to permit examination. Examiner notes that applicant has submitted new drawings (July 23, 2004) for another application (App # 10-791447, attorney docket # 3186.00004, title: Surgical instrument for implants). Examiner also notes that in the Office Action for the above-mentioned application, mailed November 29, 2005, there was an objection to the new drawings.

Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions

of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (US Pat 6277149).

Regarding claim 1, Boyle teaches of having a spinal implant, made of bone, with a superior end face, an inferior end face, and outer sidewall with at least two flat portions and two pin holes (see figure 16, col 6:10-18). Although Boyle does not teach of having a hole on each flat portions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have each flat sidewall to have a pin hole, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. Furthermore, though Boyle fails to teach the pin holes are at an angle, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the spinal implant with pin holes at an angle of 30 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233.

Regarding claim 3, Boyle teaches of having a threaded and a non threaded hole (col 6:10-18). Although Boyle does not teach of having two smooth holes, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct Boyle's spinal implant with two smooth holes, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to claim 10 and 11, Boyle teaches of making the implant from bone and shaped in its natural configuration or any other configuration. (see col 2:40-48).

Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferreira et al. (US Pat Pub 2003/0069640) in view of Boyle et al. (US Pat 6277149).

In regards to claim 13, Ferreira teaches of having a spinal implant with a superior and inferior face with concentric cuts on both faces. See paragraph 9 and 10 in the summary of the invention section. However, Ferreira fails to teach of having at least two flat sidewalls. Boyle teaches of having a spinal implant with at least two flat sidewalls (see figure 1). Thus, it would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Ferreira in view of Boyle, in order to have a spinal implant with concentric cuts on the superior and inferior faces and to have at least two flat sidewalls. This would allow easier implantation and manipulation of the spinal implant. Furthermore and in regards to claim 22, Boyle

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teaches of having the implant shaped in its "natural configuration", thus the outer sidewalls would maintain the natural shape of bone (col 2:43-48).

Conclusion

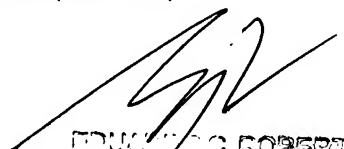
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 


EDUARDO G. ROBERT
PATENT EXAMINER